

## **REMARKS/ARGUMENT**

Applicant responds herein to the Office Action dated March 25, 2005.

Claims 1-59 and 68-81 are currently pending in the present application. Of these claims, claims 60-67 were previously canceled and claims 6, 9-59 and 68-81 were previously withdrawn. Accordingly, claims 1-3, 4, 5, 7, and 8 are currently under examination in the present application.

Applicants thank the Examiner for indicating that claims 4, 5, 7, and 8 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicant defers rendering any such allowable claims in independent form, pending resolution of the issue of allowability of other claims.

Claims 1 and 3 were amended herein to clarify the subject matter contained therein and the address the Examiner's § 112, second paragraph, concerns. It is respectfully submitted that the amendments to claims 1 and 3 do not add new matter and have adequate support throughout the Specification.

Otherwise, Applicants respectfully traverse all claim rejections for the reasons that follow:

### **I. REJECTIONS OF CLAIMS 1-5, 7, AND 8 UNDER 35 U.S.C. § 112**

Claims 1-5, 7, and 8 were rejected as indefinite under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. For the reasons discussed below, Applicants respectfully traverse and direct the Examiner's attention to the claim amendments submitted with the Preliminary Amendment filed on December 2, 2003.

The Examiner alleges that claim 1 contains two clauses reciting "a second light path member." However, claim 1 as amended by the Preliminary Amendment contains only one such clause.

The Examiner also alleges that there is insufficient antecedent basis for "said optical branch" in claim 1. However, Applicants respectfully point out that claim 1 does not recite "said optical branch."

The Examiner also alleges that it is unclear which paths in claim 3 constitute an "incident light path" and an "emitted light path." Applicants direct the Examiner's attention to claim 1, from

which claim 3 ultimately depends. Claim 1 recites "an incident light path" and "an emitted light path." Claim 3 refers to these paths recited in claim 1.

Regarding the remaining issues, claims 1 and 3 have been amended herein to address the Examiner's concerns. It is respectfully submitted that the amendments do not add new matter and have adequate support throughout the Specification.

For at least the foregoing reasons, it is kindly requested that the rejections of claims 1-5, 7, and 8 be withdrawn.

## **II. REJECTIONS OF CLAIMS 1-3 UNDER 35 U.S.C. § 103(a)**

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,201,608 to Mandella et al. ("Mandella") in view of U.S. Patent No. 6,615,072 to Izatt et al. ("Izatt").

Applicants note that the Examiner's rejection states that claims 1-3 are unpatentable over Mandella in view of U.S. Patent No. 5,291,267 to Sorin ("Sorin"), but combines Mandella with Izatt, not Sorin. (See Office Action, pages 4 and 6).

Case law makes clear that the initial burden lies with the Examiner to factually support a prima facie case of obviousness. See In re Rinehart, 531 F.2d 1048 (C.C.P.A. 1976). Specifically, the Examiner must provide a suggestion or motivation to combine references (or modify a reference), must show a reasonable expectation of success, and must demonstrate that the suggested combination teaches or suggests each and every limitation of a claim. See In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2142. If the Examiner fails to factually support a prima facie case of obviousness, Applicants are under no obligation to submit evidence of nonobviousness. Id.

Since the Examiner did not discuss the Sorin reference, much less explain how Sorin is to be combined with Mandella to render claims 1-3 obvious, it is respectfully submitted that a prima facie case of obviousness has not been set forth with respect to claims 1-3. Accordingly, Applicants are under no obligation to provide evidence of non-obviousness regarding the combination of Mandella and Sorin.<sup>1</sup>

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<sup>1</sup> Applicants believe that the Examiner's reference to Sorin was made in error, especially since Sorin was not cited in the Examiner's PTO-892 form, nor was it cited by Applicants in an

Regarding Izatt, Applicants note that this reference is prior art, if at all, only under § 102(e). However, Applicants respectfully point out that Izatt and the present application were under an obligation of assignment to the same assignee – **Olympus Optical Co., Ltd** – at the time the present application was filed and, as such, Izatt may not be used to support obviousness rejections of claims, including claims 1-3. *See* 35 U.S.C. § 103(c).

For at least the foregoing reasons, it is respectfully submitted that the rejections of claims 1-3 under 35 U.S.C. § 103(a) be withdrawn.<sup>2</sup>

### III. CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims are currently in allowable condition.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 24, 2005

_____ Max Moskowitz Name of applicant, assignee or Registered Representative
_____ Signature
_____ June 24, 2005
_____ Date of Signature

Respectfully submitted,

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Information Disclosure Statement. Furthermore, the Examiner's obviousness combination is discussed with reference to a phase modulator and Figure 6 of the Izatt reference, not Sorin.

<sup>2</sup> If the Examiner intends to cite new art or a new combination of art against claims 1-3 in a subsequent Office Action, Applicants remind the Examiner that it would not be proper to make the next Office Action Final, since new grounds of rejection based on such art would surely not be "necessitated by Applicants' amendment or based on information submitted in an Information Disclosure Statement filed in accordance with 37 C.F.R. 1.97(c)." *See* M.P.E.P. § 706.07(a).